

## **REMARKS/ARGUMENTS**

Claim Status: Claims 1-20 are presented for consideration.

### **35 U.S.C. 112 Rejection**

Claims 1-20 were rejected under §112 as failing to lack proper antecedent basis for the terms "the kit items". Appropriate correction has been made.

### **35 U.S.C. 103(a) Rejection**

Claims 1-5, 7, 9, 11-13 and 18-19 are rejected under 103(a) as being unpatentable over Armstrong in view of any one of Woodson, Melnick, and Muni.

With regards to the Armstrong application, applicant points out that the reference is a published application having a filing date of February 12, 2004. The application is a continuation-in-part of an abandoned application filed on October 5, 1998, which further claimed priority of a provisional application filed on October 6, 1997. In this instance, the public did not gain access to any of the information in the Armstrong reference until November 18, 2004, when the cited reference published. Applicant has a filing date of November 21, 2003, which is well before the February 12, 2004 filing date of Armstrong. It must be that the Examiner is relying on the abandoned application cited in the Armstrong publication of November 18, 2004 as the basis for the rejection under Armstrong. However, the effective date for the abandoned application to be available as prior art is the publication date on November 18, 2004. The law is clear that an abandoned patent application becomes available as prior art only as of the date the public gains access to it. See M.P.E.P 2127, 37 C.F.R. 1.14(e)(2), and *Oddzon Products, Inc. v. Just Toys, Inc et al*, 122 F.3d 1396, 1402 (Fed. Cir. 1997). Even

assuming that the subject matter of the abandoned application is incorporated into the Armstrong publication, an issued not addressed by the Examiner, the earliest date the subject matter can be considered to be accessible to the public is November 18, 2004. In fact, there is no express statement in Armstrong which says that it incorporates any of the information from the previous applications. It only claims a priority date. As the Examiner is no doubt familiar, 35 U.S.C. 102(e) requires the application for a patent to be published under §122(b) before the invention by the applicant for patent. In this case, the Armstrong reference was published well after the filing date of applicant. The Examiner is also referred to M.P.E.P §2141.01 which states that "a 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used in its publication or issue date." Accordingly, as the first time any of the information disclosed by Armstrong was made available at the earliest on November 18, 2004, it is clearly not obvious to a person skilled in the art in 2003 to utilize a non-existing document in combination with other references to anticipate applicant's invention. In summary, because the subject matter disclosed in Armstrong in the abandoned application was not known to the public, if at all, until the publication of the current continuation-in-part application, U.S. Pub. No. 2004/0228799, this reference is not available for citing as prior art against applicant's invention filed November 21, 2003. See also *In Re Lund* 376 F.2d 982.

Accordingly, the rejection of claims 1-5, 7, 9, 11-13 and 18-19 over Armstrong are moot. Furthermore, as claims 9 and 11 were not cited by the Examiner as being rejected under any additional prior art references, it is believed that these claims are now in condition for allowance.

Claims 1-5, 8, 12-13 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robbins in view of any one of Woodson, Melnick and Muni. Robbins is said by the Examiner to disclose a barium swallowing kit including a plurality of individual food containers each including a measured amount of a liquid or solid food of differing consistency already mixed with barium sulfate to provide variety for testing swallowing. The Examiner cites Woodson, Melnick and Muni as disclosing constituents not yet mixed. The Examiner states it would be obvious to modify the kit of Robbins in view of any one of Woodson, Melnick and Muni to provide the kit constituents in a non-mix state until ready for use.

With regards to independent claims 1 and 12, these claims have been amended to more particularly define the invention over the prior art. In particular, claims 1 and 12 call for each of the food reservoirs to include “one of a measured amount of a liquid food and a measured amount of a solid food of differing consistency to provide variety for testing the patient’s swallowing mechanism with both liquid and solid food.” Accordingly, applicant requires both solid and liquid food for testing.

The Robbins reference is focused exclusively on the application of liquid foods for use in a barium swallowing procedure. There is no disclosure or suggestion in Robbins to utilize solid food stuffs in combination with liquid food stuffs of varying consistency to provide variety for testing the patient’s swallowing mechanism. More specifically, referring to column 4, lines 4 through 6, Robbins states that “The combination comprises three solutions: the first a “thin” composition, the second a “nectar thick” composition and the third a “honey thick” composition.” The entire patent is directed towards the formation and utilization of these three liquid solutions.

Accordingly, as there is no suggestion or motivation to incorporate the use of a solid food into a kit for testing swallowing mechanisms, it would not be obvious to a person skilled in the art to combine Robbins with any one of Woodson, Melnick and Muni to derive applicant's invention.

With regards to claim 18, the claim specifically calls for food reservoirs that include a measured amount of solid food of differing consistency to provide variety for testing the patient's swallowing mechanism, as well as a plurality of liquid food containers that include a measured amount of liquid food of differing consistency for variety for testing the patient's swallowing mechanism. Nowhere does Robbins or any of the other cited references disclose providing solid foods of differing consistency in combination with liquid foods of differing consistency. As stated above, as there is no suggestion or motivation to combine Robbins with any one of Woodson, Melnick or Muni to teach a kit that uses both liquid and solid foods of differing consistency to test a patient's swallowing mechanism, it is thus not obvious to a person skilled in the art to combine the cited references to derive applicant's invention. Thus, applicant believes that claim 18 is patentable over Robbins in view of any one of Woodson, Melnick and Muni.

Accordingly, it is believed that claims 1, 12 and 18 are in condition for allowance and that claims 2-11, 13-17, and 19-20 which depend from the above claims are also in condition for allowance for the above reasons. Furthermore, as the only rejections to claims 9 and 11 were under Armstrong, which is not applicable as a prior art reference, it is believed that claims 9 and 11 are allowable for this additional reason.

Applicant now believes that the case is in condition for allowance and respectfully

requests passing of the case to issuance in due course of patent office procedure.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Seann P. Lahey', with a stylized flourish extending to the right.

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